

### REMARKS

Claims 26-92 are pending in the application. Claims 26-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/641, 856; 10/323, 192 and 10/256,412. Claims 35, 38-39 and 54 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stanley (U.S. Patent No. 5,411,104). Claims 40, 42, 43, 44, 45 and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent No. 5,435,400) in view of Stanley. Claims 40, 41, 46, 48, 50 and 61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller et al. (U.S. Patent No. 5,355,967) in view of Stanley. Claims 40, 42, 43, 51 and 52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen (US Pat no 4,134,463) in view of Stanley. Claims 26, 27, 31, 32, 33, 34, 47 and 54-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller in view of Stanley. Claims 26, 28-30, 35-37, 53-55, 57, 58, 59, 60 and 62 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Stanley. Applicant respectfully requests reconsideration of the Application in view of the amendments and remarks herein.

#### ***Claim Rejections - 35 U.S.C. § 102***

Claims 35, 38, 39 and 54 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stanley (U.S. Patent No. 5,411,104). Independent claim 35, as amended, recites "reducing a weight of drilling fluid in the well bore." Independent claim 54 includes a similar recitation. Stanley fails to disclose reducing the weight of the drilling fluid, and thus fails to anticipate claims 35 and 54. Accordingly, Applicant respectfully requests withdrawal of the rejections to claim 35 and its dependent claims 38 and 39 and claim 54 under 35 U.S.C. § 102(b).

#### ***Claim Rejections - 35 U.S.C. § 102***

Claims 26, 28-30, 35-37, 40, 42, 43, 44, 45, 49, 53-55, 57-60 and 62 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent No. 5,435,400) in view of

Stanley. Independent claim 26, as amended, recites "reducing a weight of drilling fluid in the well bore." Independent claims 35 and 54 include similar recitations. Neither Smith nor Stanley disclose reducing the weight of the drilling fluid. Thus, the combination of Smith and Stanley fails to render claims 26, 35 and 54 obvious. Accordingly, Applicant respectfully requests withdrawal of the rejections to claims 26, its dependent claims 28-30 and 59, claim 35, its dependent claims 36, 37 and 60, and claim 54 and its dependent claims 55, 57, and 58 under 35 U.S.C. § 103(a).

Further regarding the Stanley's teaching away from combination with Smith, it is well established that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cirt. denied*, 469 U.S. 851 (1984). See also MPEP § 2141.02. Stanley specifically states that liquid based systems damage the near well bore coal seam formation, because mud and cuttings flow into the existing natural fractures (col. 3, lines 32-37 and lines 59-60). Smith discloses a liquid based system. Accordingly, because Stanley teaches away from combination with Smith, Applicant respectfully requests withdrawal of the rejections of claims 26, 28-30, 35-37, 40, 42, 43, 44, 45, 49, 53-55, 57-60 and 62 under 35 U.S.C. § 103(a).

Claims 26, 27, 31, 32, 33, 34, 40, 41, 46, 47 48, 50, 54-56, and 61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller et al. (U.S. Patent No. 5,355,967) in view of Stanley. Independent claim 26, as amended, recites "reducing a weight of drilling fluid in the well bore." Independent claim 54 includes similar recitations. Neither Mueller nor Stanley disclose reducing the weight of the drilling fluid. Thus, the combination of Mueller and Stanley fails to render claims 26 and 54 obvious. Accordingly, Applicant respectfully requests withdrawal of the rejections to claims 26, its dependents 27, and 31-34 and claims 54 and its dependent claims 55 and 56.

Like Smith discussed above, Mueller discloses a liquid based system. Accordingly, Stanley teaches away from combination with Mueller, and Applicant respectfully requests

withdrawal of the rejections to claims 26, 27, 31, 32, 33, 34, 40, 41, 46, 47 48, 50, 54-56, and 61 under 35 U.S.C. § 103(a).

Claims 40, 42, 43, 51 and 52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen (US Pat no 4,134,463) in view of Stanley. Like Smith discussed above, Allen discloses a liquid based system. Accordingly, Stanley teaches away from combination with Allen, and Applicant respectfully requests withdrawal of the rejections to claims 40, 42, 43, 51 and 52 under 35 U.S.C. § 103(a).

### ***Information Disclosure Statements***

Upon reviewing the file, Applicant noted that they have not received an initialed copy of the PTO Form 1449s that accompanied information disclosure statements filed January 11, 2005 and March 24, 2005. Applicant believes these information disclosure statements complied with 37 CFR 1.97. Thus, Applicant respectfully requests that the examiner initial and return these forms as soon as possible. Applicant is filing this request concurrently with a Request for Continued Examination and has enclosed the RCE fee under 37 CFR §1.17(e).

### ***Conclusion***

In view of the above, and for other reasons clearly apparent, Applicants respectfully submit that the Application is in condition for allowance, and request such a Notice. If the present Application is not allowed and/or if one or more of the rejections is maintained or made final, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule a telephone conference.

This Amendment is being filed simultaneously with a Request for Continued Examination, along with all applicable fees. A check in the amount of \$130 for the terminal disclaimer fee, and a check in the amount of \$450 for a two month extension of time are also included. Additional claims fees were paid for the new claims in the Supplemental Amendment mailed March 24, 2005. Please apply any deficiencies or any other required fees or any credits to deposit account 06-1050, referencing the attorney docket number shown above.

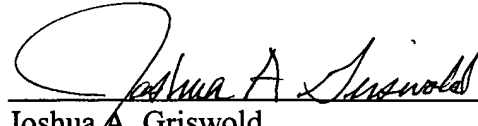
Applicant : Joseph A. Zupanick  
Serial No. : 10/630,345  
Filed : July 29, 2003  
Page : 18 of 18

Attorney's Docket No.: 17601-043001 / 067083.0205

Respectfully submitted,

Date: \_\_\_\_\_

9/1/05

A handwritten signature in dark ink, appearing to read "Joshua A. Griswold", is written over a horizontal line.

Joshua A. Griswold  
Reg. No. 46,310

Fish & Richardson P.C.  
1717 Main Street  
Suite 5000  
Dallas, Texas 75201  
Telephone: (214) 292-4034  
Facsimile: (214) 747-2091

90122818.doc